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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Ryoichi KAWADA et al.**

Group Art Unit: **2614**

Serial No.: **09/934,539**

Examiner: **Paulos M. Natnael**

Filed: **August 23, 2001**

Confirmation Number: **7826**

For: **APPARATUS FOR ASSESSING QUALITY OF A PICTURE IN TRANSMISSION,
AND APPARATUS FOR REMOTE MONITORING QUALITY OF A PICTURE
IN TRANSMISSION**

Attorney Docket Number: **011034**

Customer Number: **38834**

REQUEST FOR RECONSIDERATION

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

December 29, 2005

Sir:

Applicants respond herein to the Office Action of October 5, 2005 with the present request for reconsideration.

Claims 1, 2, and 4 stand rejected under 35 U.S.C. § 112, first paragraph, as having an inadequate written description. Applicants respectfully traverse this rejection.

In applicants' submission of July 13, 2005, the following text was added to claim 1:

wherein the apparatus does not require that the characteristic values, which are extracted from the picture transmission path, be reinserted back into the picture transmission path, and

wherein the apparatus does not require that characteristic values extracted at one of the predetermined points be delayed in time for synchronization to match characteristic values extracted at another of the predetermined points.

Applicants added only the second paragraph of this text to claim 2. Claim 4, which depends from claim 2, now recites the second paragraph by virtue of its dependency. Claims 1, 2, and 4,

are now rejected based on the belief that applicants' specification does not adequately describe the newly-added subject matter.

It is implied in the Office Action (page 2, bottom) that the rejection could be withdrawn, if applicants would indicate specific text in the specification that corresponds to the text added to the claims in the amendments. (Of course, under MPEP §§ 2163.02 & 2163.06, a disclosure in the drawings can also suffice to show written description support.)

However, the specification does not need to provide *explicit* written description support for the claims, because an inherent disclosure can suffice. Applicants reference MPEP § 2163.07(a), which includes:

By disclosing in a patent application a device that inherently performs a function ..., a patent application necessarily discloses that function, ... even though it says nothing explicit concerning it.

Applicants respectfully submit that it should not be disputed that their specification inherently discloses an apparatus that: (1) does not require that characteristic values, which are extracted from a picture transmission path, be reinserted back into the picture transmission path; and (2) does not require that characteristic values extracted at one predetermined point be delayed in time for synchronization to match characteristic values extracted at another predetermined point. Certainly, the Office Action provides no argument that this subject matter is not inherent thereby rendering MPEP § 2163.07(a) inapplicable.

Applicants appreciate the courtesy extended by the Examiner-of-record in granting the telephone interview of December 13, 2005. During the interview, applicants' representative discussed the inherent support for the claims. Although the Examiner did not think it appropriate to provide an immediate commitment regarding the withdrawal of the rejection, he indicated a

willingness to consider carefully the arguments after receiving a formal request for reconsideration.

In view of the explanation above, applicants request the withdrawal of the rejection based on an inadequate written description.

In a separate matter, applicants acknowledge with appreciation the allowance of claim 3.

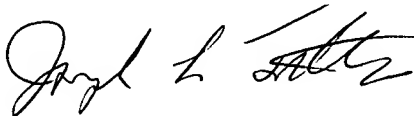
As a final matter, applicants again request acknowledgement of their claim for foreign priority.

Applicants now submit that the entire application is in condition for allowance, and a Notice of Allowability is hereby requested. If for any reason it is believed that this application is not now in condition for allowance, the Examiner is welcome to contact applicants' undersigned attorney at the telephone number indicated below to discuss resolution of the remaining issues.

If this paper is not timely filed, applicants petition for an extension of time. The fee for the extension, and any other fees that may be due, may be debited from Deposit Account No. 50-2866.

Respectfully submitted,

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